REMARKS

The Office Action mailed February 26, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Summary of Claims

Claims 1-14 and 16-37 are currently pending in the application, with claims 1, 17, 20, and 28 being independent claims. Claims 38-48 are cancelled, in accordance with the above amendments, and Applicants reserve the right to file a divisional application including method claims similar to cancelled claims 38-48.

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 17-19 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 6,487,796 to Avar, et al.; and
- Claims 1-5 and 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Avar and U.S. Patent Number 6,457,261 to Crary.

II. Discussion of References

Avar discloses an article of footwear having a sole component that includes four generally cylindrical support elements or columns 108a-108d. An o-ring indentation 124 extends at least partially around an exterior surface of each column 108a-108d, and an o-ring 126 is received within the o-ring indentation 124. More specifically, the specification of Avar states that "[o]-ring indentation 124a is a horizontal indentation in vertical surface 118a that extends around a majority of the circumference of column 108a....Received in o-ring indentation 124a is o-ring 126a..." (column 7, lines 50-52 and 59). Similar recitations are made for columns 108b-108d. Accordingly, the bands that encircle the exterior surface of each column 108a-108d are disclosed as having the structure of an o-ring.

Crary also discloses an article of footwear that includes four support elements. Whereas the support elements of Avar are generally cylindrical, the support elements of Crary have a stepped configuration that is described as being a telescopic shock absorber.

III. Discussion of O-Ring Structure

The band in Avar is disclosed as having the structure of an o-ring. In a Response dated July 8, 2003, Applicants stated that an o-ring is generally recognized as having a circular cross-section. In reply to the argument, the Examiner stated that "there are many different types of o-rings available and the assumption that an o-ring is generally recognized...as having a circular cross-section is incorrect" (see Office Action of September 23, 2003). This assertion appears to be based upon facts within the personal knowledge of the Examiner. In accordance with the requirements of 37 C.F.R. §1.104(d)(2) "the reference must be supported, when called for by the applicant, by the affidavit of such employee...." Accordingly, Applicants hereby respectfully request that the Examiner provide an affidavit in support of this assertion.

As demonstrated in the following material, the technical definition of an o-ring is generally recognized as only including those rings with a circular cross-section. As a first matter, a ring may be generally defined as is a band with a generally circular structure, and rings may have a variety of cross-sectional shapes (e.g., round, square, rectangular, triangular, or non-regular). In contrast with the concept of a ring, an o-ring is a specific type of ring. More particularly, an o-ring has not only a circular structure, but also has a circular cross-section. Accordingly, the "o" modifier in the term "o-ring" connotes the presence of a circular cross-section. That is, the "o" modifier in o-ring would be redundant if an o-ring were the same as a ring.

Included with this Amendment is a copy of a Parker O-Ring Handbook, which is a generally recognized reference guide for o-ring information. Applicants refer to section 1.1 of the Parker O-Ring Handbook, which states that "[a]n o-ring is a torus, or donut-shaped ring." Similarly, section 1.2 states that "[a]n O-ring is a circular cross-section ring...." These definitions of the term "o-ring" are consistent with each reference and figure of an o-ring that is provided in the following approximately 250 pages of text in the Parker O-ring Handbook.

Similar concepts are evident from a review of other technical literature. For example, an o-ring guide produced by the Busak+Shamban Group in 1999 indicates that "[o]-rings...are characterized by their circular form with annular cross section" (see page 3). In addition, a guide from an Allorings.com Web site indicates that "[t]wo dimensions define the size of an O-ring: its inside diameter (ID) and its cross-sectional diameter (CS)", which implies a circular cross-section. Each of the three references discussed above are included with this Amendment for the Examiner's reference.

Based upon the above discussion, Applicants submit that an o-ring, by definition, has a circular cross-section. Furthermore, Applicants respectfully invite the Examiner to support the Examiner's assertion, with an affidavit, that "the assumption that an o-ring is generally recognized...as having a circular cross-section is incorrect" (see Office Action of September 23, 2003).

IV. The Claims Patentably Distinguish Over The Applied Prior Art

Independent claim 1 recites the features of an article of footwear having an upper for receiving a foot of a wearer and a sole attached to the upper. The sole has at least one support element that includes an exterior surface. An upper portion and a lower portion of the exterior surface slope outward to form a ridge that encircles the support element. The support element also has at least one band that encircles the exterior surface. In addition, the support element includes a structure different from the band that facilitates movable positioning of the band with respect to the exterior surface to thereby alter deflection and stiffness characteristics of the support element.

The rejection of independent claim 1 states that "the band is shown in Figure 3 [of Avar] to extend flatly outward." The specification of Avar unambiguously states, as discussed above, that o-rings are received in the o-ring indentations. Accordingly, the Examiner's interpretation of Avar does not account for the totality of the teaching in Avar. It is generally impermissible for an Examiner to rely upon selected elements from any one reference in support of a given position to the exclusion of other parts of the reference that are necessary for a full appreciation of what the reference fairly suggests to one skilled in the art. More particularly, a prior art

reference must be considered in its entirety (i.e., as a whole) including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). A consideration of Avar as a whole indicates, therefore, that the band has a circular cross-section.

It is well-established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue. *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491. In this case, the specification is not completely silent on the issue. Rather, the specification of Avar is definite as to the technical description of the bands. In other words, the specification states that the band is an o-ring. Accordingly, Applicants again submit that Avar should be interpreted in accordance with (and that the Examiner should not disregard) the unambiguous teaching of the specification, which states that the band is an o-ring.

Independent claim 17 recites the features of an article of footwear that includes an upper for receiving a foot of a wearer and a sole attached to the upper. The sole has at least one support element that includes an exterior surface; at least one band encircling the exterior surface; and at least one flange attached to the band and extending outward from the band. The flange facilitates movable positioning of the band with respect to the exterior surface to thereby alter deflection and stiffness characteristics of the support element.

As discussed relative to independent claim 1, Avar does not teach the band as extending outward as Avar only teaches the presence of an o-ring. More particularly, Avar does not teach the presence of a flange extending from the band. In the rejection of independent claim 17, the Examiner states that "the band [in Avar] is shown in Figure 3 to extend flatly outward." Independent claim 17 does not recite the band as extending outward. Rather, independent claim 17 recites that the flange, which is different from the band and attached to the band, extends outward.

Based upon the above discussion, Avar does not teach a structure that facilitates movable positioning of a band. Furthermore, Avar merely discloses a band having the configuration of an o-ring and does not disclose, therefore, a flange attached to the band that facilitates movable positioning of the band. Accordingly, Applicants respectfully submit that independent claims 1

and 17 are allowable over Avar, and that claims 2-5, 11-14, and 18-19 are allowable for at least the same reasons.

V. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by hand filing on May 13, 2004. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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